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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Satoshi Niwano

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WENDEROTH, LIND & PONACK L.L.P.

1030 15th Street, N.W.

Suite 400 East

Washington, DC 20005-1503

EXAMINER

RAVETTI, DANTE

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

08/01/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com

coa@wenderoth.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,881	<b>Applicant(s)</b> NIWANO ET AL.	
	<b>Examiner</b> DANTE RAVETTI	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This communication is in response to the request for continued examination of Application No. 10/581,881 filed on 8 July 2010.
2. Claims 1-23 have been cancelled by the Applicant.
3. Claims 24-35 are currently pending and have been fully examined.
4. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

### ***Examiner's Comments/Remarks***

5. Applicant's response, filed on 8 June 2010, has been fully considered, but is moot in light of a new ground's of rejection necessitated by Applicant's newly amended claim limitations.

As to claim 24, Applicant recites, "...processor programmed to operate as...." However, this does not appear to be in proper Beauregard form (e.g. instructions stored/saved on a medium, when executed, causes a computer/processor to perform the steps of...).

In light of Applicant's choice to pursue system claims, Applicants are also reminded that functional recitations using the word "for," "adapted to", "configured to," or other functional terms (e.g. see claim 24 which recites "...a first license generation unit generating, in a first format, **a first license for controlling content use in the terminal device**;" ) have been considered but are given little patentable weight<sup>1</sup> because they fail

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<sup>1</sup> See e.g. In re Gulack, 703 F.2d 1381, 217 USPQ 401,404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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to add any structural limitations and are thereby regarded as intended use language.

To be especially clear, all limitations have been considered. However a recitation of the intended use in a system claim must result in a structural difference between the claimed system and the prior art in order to patentably distinguish the claimed system from the prior art.

Claims 27-29, 32 and 34 contains similar language found in claim 24.

As to claim 25, Applicant recites, “**when** (i) a frequency band of the transmission path is narrower....” The MPEP interprets claim limitations that contain “if, may, might, can, **when** and could” statement(s), as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.<sup>2</sup> Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.<sup>3 4 5 6</sup>

Claim 30 contains similar language found in claim 25.

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<sup>2</sup> In re Johnston, 77 USPQ2d 1788 (Fed. Cir. 2006); As matter of linguistic precision, optional claim elements do not narrow claim, since they can always be omitted; in present case, elements of dependent claim directed to large diameter spirally formed pipe, which recite “further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased,” do not narrow scope of claim compared to claims lacking those elements, since elements are stated in permissive form “may.”

<sup>3</sup> MPEP §2106 II C; Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation;

<sup>4</sup> Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); Because the language of claim 1 refers to “programmable selection means” and states “whereby when said alternate addressing mode is selected” (emphases added), the accused device, to be infringing, need only be capable of operating in the page mode. Contrary to GI/M's argument, actual page mode operation in the accused device is not required.

<sup>5</sup> In re Venezia, 189 USPQ 149 (C.C.P.A. 1976); However, we found that the claim did not positively recite any structural relationship between the two elements identified as [1] and [2], in its recitation of what may or may not occur. We concluded that the claim failed to comply with section 112, second paragraph, in “failing distinctly to claim what appellant in his brief insists is his actual invention.”

<sup>6</sup> In re Collier, 158 USPQ 266 (CCPA 1968); It has been held that actions that may or may not be done is indefinite and does not distinguish the claim from the prior art;

Clauses (e.g. whereby, thereby, wherein) that merely states the result of the limitation(s) of a claim(s) does not limit the scope of the claim(s).<sup>7</sup> Therefore, the data size of the license, as recited in claim 26, for example, will not limit the scope of the claim.

Claim 31 contains similar language found in claim 26.

Examiner would also like to point out that Official Notice was used in the previous office action mailed on 8 March 2010 to indicate that whose format is converted by the format conversion unit based on the digital signature were old and well known in the art. Since applicant has not attempted to traverse this Official Notice statement, Examiner is taking the common knowledge or well-known statement to be admitted prior art.<sup>8</sup>

***Continued Examination Under 37 C.F.R.- §1.114***

6. A request for continued examination under 37 CFR §1.114, including the fee set forth in 37 CFR §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR §1.114, and the fee set forth in 37 CFR §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR §1.114. Applicant's submission filed on 8 July 2010 has been entered.

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<sup>7</sup> MPEP §2111.04[R-3]; MPEP §2106 II C; §2106.01; MPEP §2114;

<sup>8</sup> See MPEP 2144.03 C;

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 24-34 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Claim 24 is directed to a system comprising:

operate as with the following units:

a first license **generation unit** generating, in a first format, a first license for controlling content use in the terminal device;

a modification detection information **generation unit** generating a digital signature for detecting a modification of the first license and sending the generated digital signature to the relay server,

depending on a status of a transmission path to the terminal device;

a specification information **receiving unit** receiving an input of format specification information that is an instruction, to the terminal device, for converting a format of a second license to the first format; and

a specification information **sending unit** sending the received format specification information to the relay server,

Even though the claim recites "system" the body of the claim discusses unit and it does not recite any actual technical system components. Claim 24 is directed to software per se as it recites "unit." Software is defined as "Microsoft Press Dictionary Definition" or "IEEE Definition." According to MPEP 2106 II IV, however, there are four categories of invention: process, machine, article of manufacture or composition of matter. Therefore, as "software" is neither a category of invention nor a subset of one of the categories it does not represent patent eligible subject matter.<sup>9</sup> A system or

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<sup>9</sup> In re Nuijten;

apparatus claim should always contain the structure or the hardware that performs the function Applicant claims. Therefore, the claimed system is non-statutory and therefore rejected under 35 U.S.S. §101.<sup>1</sup>

Claims 29, 32 and 34 contains similar language or like deficiencies found in claim 24.

Claims 25-28 and 30-31 are also rejected for being dependent upon rejected claims 24 and 29.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over REMER et al., (US 2003/0088516) ("REMER") and in view of Nakahara et al., (US 2003/0048907) ("Nakahara").

#### **As to Claims 24 29, 32, 34 and 35:**

REMER teaches substantially as claimed:

A content distribution system comprising ([0008]-[0009], [0011], [0012], [0015], [0031], [0034], [0054], [0056], Claim 11);

a license management server (Abstract, [0021], [0029]-[0034], [0054], [0081], [0083], [0094]);

a relay server (Abstract, [0012], [0016], [0021]-[0024], [0048], [0052], [0054]-[0055], [0077], Figure 3A); and

a terminal device (Figure 1);

wherein the license management server includes at least one processor programmed to operate as with the following units (Abstract);

a first license generation unit generating, in a first format, a first license for controlling content use in the terminal device ([0021]-[0023], [0027]-[0028]);

a modification detection information generation unit generating a digital signature for detecting a modification of the first license and sending the generated digital signature to the relay server ([0077], [0078], [0080]);

a specification information sending unit sending the received format specification information to the relay server ([0012], [0016], [0021]-[0024], [0080]-[0081]);

wherein the relay server includes at least one processor programmed to operate as:

a second license generation unit (i) generating, in a second format, the second license by adding, to the first license, the digital signature for detecting the modification of the first license ([0077], [0078], [0080]);

and (ii) adding, to the generated second license, the format specification information received by the license management server ([0028], Claim 4);

wherein the terminal device includes at least one processor programmed to operate as:

a format conversion unit obtaining the second license from the relay server and converting the format of the second license into the first format, according to the format specification information added to the second license (Figures 2, 3)

a judgment unit judging a presence or absence of the modification of the first license using the digital signature for detecting the modification of the first license having a, format converted from the second format into the first format by the format conversion unit ([0077], [0078], [0080]); and

a use unit using the content according to the first license when the judgment unit judges that no modification is made ([0005], [0007], [0011], [0019], [0033], [0080]);



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REMER does not expressly teach:

a specification information receiving unit receiving an input of format specification information that is an instruction, to the terminal device, for converting a format of a second license to the first format;

the second format being different from the first format,

However, REMER expressly teaches:

[0023] Because the POS is self -licensing, any number of service agents can purchase licenses for any given POS computer with which the service agent can connect via a local or remote network. In an implementation of the method, the service agent may reside on one or more service management consoles. The consoles themselves are not licensed, but rather provide the conduit through which the licenses flow between the POS and the third party. The service agent maintains copies of collected POS licenses and new purchased licenses issued by the third party in a discovery database. **The service agent synchronizes the collection of licenses from POS as well as the replacement of the POS licenses with new licenses using the discovery database**

REMER teaches the "replacement" of a POS license with a "new license." To one of ordinary skill in the art would know that this "replacement" is an example of a conversion of a format of a second license to a first. Therefore, a predictable result of REMER would have been to have a specification information receiving unit receiving an input of format specification information that is an instruction, to the terminal device, for converting a format of a second license to the first format and the second format being different from the first format.<sup>10</sup>

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<sup>10</sup> Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement.

REMER does not expressly teach:

depending on a status of a transmission path to the terminal device;

Nakahara does not expressly teach:

depending on a status of a transmission path to the terminal device;

However, Nakahara expressly teaches:

[0118] The central processing section 12 transfers the generated format transmission requests Dfm1 and Dfm2 from the working area 13 to the communication section 14. The communication section 14 transmits the received format transmission requests Dfr1 and Dfr2 to the servers 21 and 31 via the transmission path N (step S315).

[0119] In the servers 21 and 31 (see FIG. 2 and FIG. 6), the communication sections 217 and 317 receive format transmission requests Dfr1 and Dfr2 from the transmission path N, and transfer and store them to the working areas 216 and 316 (step S316). After interpreting the stored format transmission requests Dfr1 and Dfr2, the central processing sections 215 and 315 retrieve the format data Dfm1 and Dfm2 stored in the format storage sections 218 and 318 onto the working areas 216 and 316 (step S317).

[0121] In the conversion apparatus Uc1 (see FIG. 9), the communication section 14 receives format data Dfm1 and Dfm2 from the transmission path N, and transfers and stores them to the working area 13 (step S319). Next, by referring to the format data Dfm1 and Dfm2, the central processing section 12 converts the license information Dlc1 into the license information Dlc2 (step S320).

Therefore, a predictable result of Nakahara would have been to take in consideration of the “transmission path” to the terminal device because in the field of distributing content consideration of “transmission paths” are important for efficient and expedient lines for distributing content.<sup>11</sup> Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify REMER to include the features of Nakahara

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<sup>11</sup> Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement.

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because in the field of distributing content, it is common to take into consideration “transmission paths” when distributing content to a terminal device.

**As to Claims 25 and 30:**

REMER discloses substantially as claimed:

the modification detection information generation unit sends the generated digital signature to the relay server and instructs the relay server to generate the second license ([0077], [0078], [0080]);

REMER does not expressly teach:

when (i) a frequency band of the transmission path is narrower than a frequency band predetermined by a characteristic of the transmission path, or (ii) a communication speed of the transmission path is slower than a communication speed predetermined by the characteristic of the transmission path,

However, Nakahara expressly teaches:

[0118] The central processing section 12 transfers the generated format transmission requests Dfm1 and Dfm2 from the working area 13 to the communication section 14. The communication section 14 transmits the received format transmission requests Dfr1 and Dfr2 to the servers 21 and 31 via the transmission path N (step S315).

[0119] In the servers 21 and 31 (see FIG. 2 and FIG. 6), the communication sections 217 and 317 receive format transmission requests Dfr1 and Dfr2 from the transmission path N, and transfer and store them to the working areas 216 and 316 (step S316). After interpreting the stored format transmission requests Dfr1 and Dfr2, the central processing sections 215 and 315 retrieve the format data Dfm1 and Dfm2 stored in the format storage sections 218 and 318 onto the working areas 216 and 316 (step S317).

[0121] In the conversion apparatus Uc1 (see FIG. 9), the communication section 14 receives format data Dfm1 and Dfm2 from the transmission path N, and transfers and stores them to the working area 13 (step S319). Next, by referring to the format data Dfm1 and Dfm2, the central processing section 12 converts the license information Dlc1 into the license information Dlc2 (step S320).

Therefore, a predictable result of Nakahara would have been to take in consideration of the “transmission path” to the terminal device because in the field of distributing content consideration of “transmission paths” are important for efficient and expedient lines for

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distributing content.<sup>12</sup> Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify REMER to include the features of Nakahara because in the field of distributing content, it is common to take into consideration “transmission paths” when distributing content to a terminal device.

**As to Claims 26 and 31:**

REMER expressly teaches:

wherein the second license generation unit generates the second license so that a data size of the second license generated in the second format is smaller than a data size of the first license generated in the first format ([0012], [0016], [0021]-[0024], [0080]-[0081]);

**As to Claim 27:**

REMER expressly teaches:

wherein the at least one processor of the relay server is programmed to operates as a second sending unit sending the second license to the terminal device via the transmission path different from the transmission path in the case of using the license management server,<sup>13</sup> and wherein the at least one processor of the terminal device is programmed to obtain the second license from the second sending unit (Abstract, [0012], [0016], [0021]-[0024], [0048], [0052], [0054]-[0055], [0077], Figure 3A);

**As to claim 28:**

REMER expressly teaches:

further comprising a plurality of servers, each of the plurality of servers being the relay server (Abstract, [0012], [0016], [0021]-[0024], [0048], [0052], [0054]-

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<sup>12</sup> Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007); Claims in application for patent on pocket insert for book are obvious in view of combination of two prior art patents, since claims are combinations that merely unite old elements with no change in their respective functions, and which yield predictable results, since neither applicant's specification nor her arguments present any evidence that modifications necessary to effect combinations are uniquely challenging or difficult for person of ordinary skill in art, and since claimed improvement is no more than simple substitution of one known element for another, or mere application of known technique to piece of prior art ready for improvement.

<sup>13</sup> In re Harza, 124 USPQ 378 (CCPA 1960); Mere duplication of parts has no patentable significance unless new and unexpected result is produced;

[0055], [0077], Figure 3A);

wherein the at least one processor of each of the plurality of relay servers is programmed to operate as an "n" th license generation unit generating an "n" th ("n" is a natural number that is 2 or greater) license, in an "n" th format, by adding, to the first license, the digital signature for detecting the modification of the first license, the "n" th format being different from the first format,<sup>14</sup> and wherein the format conversion unit of the terminal device obtains the "n" th license from one relay server of the plurality of relay servers and further operable to convert converts the format of the "n" th license into the first format (Abstract, [0012], [0016], [0021]-[0024], [0048], [0052], [0054]-[0055], [0077], Figure 3A);

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Mr. Dante Ravetti whose telephone number is (571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

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<sup>14</sup> Id;

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PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system see

<http://pair-direct.uspto.gov>. Should you have questions on access to the private

PAIR system, please contact the Electronic Business Center (EBC) at 1-(866)

217-9197. If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 1-(800) 786-

9199 (IN USA or CANADA) or 1-(571) 272-1000.

/Dante Ravetti/

Examiner, Art Unit 3685

7/26/2011